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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,428	06/02/2005	Tim Neil	93422-49	3154
22463	7590	01/28/2008		
SMART AND BIGGAR 438 UNIVERSITY AVENUE SUITE 1500 BOX 111 TORONTO, ON M5G2K8 CANADA			EXAMINER LE, DEBBIE M	
			ART UNIT 2168	PAPER NUMBER
			MAIL DATE 01/28/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/537,428	Applicant(s) NEIL ET AL.	
	Examiner DEBBIE M. LE	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/2/05; 3/1/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5, 6, 9, 10, 11, 12, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 28 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-16 of copending Application No. 09/846,781. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claims 1-16 of the patent application 09/846,781 contain elements of claims 1, 2, 5, 6, 9, 10, 11, 12, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 28 of the instant application and as such anticipates claims of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in for prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ 2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). "ELILILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeal for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001)".

Thus, this is a **provisional** obviousness-type double patenting rejection.

### ***Claim Objections***

Claim 8, line 1 the term "sad" is objected to because of the following informalities:  
the term "sad" is suggested to change to --said--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Yach (US Patent Application. Pub. No 2002/0112078 A1).

As per claim 1, Yach discloses **[a] method of presenting data from an application** (web browser application) **executing at a computing device** (Fig. 1, host device) **at a wireless mobile device remote** (Fig. 1, device side) **from said computing device, said method comprising:**

**receiving at said mobile device, a representation of a text file** (para. 0002, displaying web content on a client device) **defining**

**a user interface and actions to be taken in response to user interaction with said user interface or received data from said application** (para. 0045, as visual output, a screen and output media components displays to the user the existing state of the VM environment, wherein the wireless handheld device receives the defined virtual machine language, para. 0041, output the common run-time virtual machine (hereinafter "VM") programs into an optional byte-code generator that accepts the VM program as input and turns the source code representation into byte-code representations);

**receiving data from said application** (Fig. 3, para. 0047, receiving program directly from file explorer and storage interface from file storage);

**executing virtual machine software at said mobile device to present said user interface and said received data, in accordance with said text file** (para. 0042,

0045, an end-user device for executing virtual machine programs to display the information, such as listings of program);

**wherein at least one of said actions in said text file specifies execution of a software component (para. 0007, para. 0036-0037) separate from said virtual machine software, identified in said text file and loaded at said device (para. 0006, virtual machine programs for direct execution by the virtual machine operating at the client machine); and**

**executing said software component at said device in response to said at least one of said actions (para. 0048, 0050).**

As per claim 2, Yach further teaches passing to said software component, parameters identified in said text file (para. 0037-0038 ).

As per claim 3, Yach further teaches querying whether said software component identified in said text file is loaded at said device (para. 0047, retrieving program to be executed from the file system or file explorer and storage interface).

As per claim 4, Yach further teaches querying whether said software component includes a pre-determined interface (para. 0030).

As per claim 5, Yach further teaches receiving data from said software component to be used by said virtual machine software (para. 0047).

As per claim 6, Yach further teaches software component is in the form of a software object, and further comprising creating an instance of said software object (para. 0036).

As per claim 7, Yach teaches wherein said text file identifies said object by name, and said method further comprises querying whether an object having said name exists at said mobile device (para. 0037, 0044).

As per claim 8, Yach teaches executing operating system software at said (sic) device, wherein said querying comprises querying said operating system to determine if said software component is present at said device (para. 0047)

As per claim 9, Yach teaches wherein said text file is received at said wireless device and wherein said text file is an XML file (para. 0010).

As per claim 10, Yach teaches wherein said text file is parsed, and a representation of said text file is stored at said wireless device for use by said virtual machine software (Fig. 3, para. 0046, 0034).

As per claim 11, Yach teaches storing data generated by said software component at said wireless device in accordance with said text file (Fig. 3, para. 0046, 0034).

As per claim 12, Yach teaches wherein said format of network messages comprises XML definitions for said network messages, and wherein data for said application are dispatched from said wireless device using said XML definitions (para. 0006).

As per claim 13, Yach teaches software component captures the signature of a user (para. 0034).

As per claim 14, Yach teaches software component interfaces with peripheral hardware at said device (Fig. 3, para. 0046).

As per claim 15, Yach discloses [a] wireless mobile device comprising:

**a processor** (Fig. 1, device side, para. 0009), **computer readable memory in communication with said processor, storing virtual machine software controlling operation of said wireless mobile device** (para. 0010, transmitting virtual machine language to a wireless handheld device), **said virtual machine software comprising:**

**a parser (VM interpreter ) for receiving a text file** (para. 0002, displaying web content on a client device);

**a screen generation engine** (byte code generator), **for presenting at least one screen at said device in accordance with said text file** (para. 0012, 0009, a wireless handheld device receives the defined virtual machine language, para. 0041, output the common run-time virtual machine (hereinafter "VM") programs into an optional byte-code generator that accepts the VM program as input and turns the source code representation into byte-code representations, or para. 0007, the translated VM program );

**an event handler for processing events arising in response to interaction with said at least one screen in accordance with said text file** (para. 0045, file explorer and storage interface component uses the screen and output media component in response to user's making selections on the virtual output listing of programs), **said event handler operable to execute a software component** (Fig. 3, #550, para. 0047, para. 0036-0037, after the virtual machine program has been retrieved by the explorer and storage interface component, the virtual machine launches



with an indicator of which program to execute) **separate from said virtual machine software, identified in said text file and loaded at said device.**

As per claim 16, Yach teaches wherein said memory further stores a representation of said text file (Fig. 3, para. 0046, file explorer and storage interface, file storage).

As per claim 17, Yach teaches wherein said representation of said text file is created by said parser (para. 0011, VM interpreter).

As per claim 18, Yach teaches wherein said parser comprises an XML parser (para 0020).

As per claim 19, Yach teaches wherein said virtual machine software further adapts said processor to parse said text file (para. 0020).

As per claim 20, Yach teaches wherein said virtual machine software further adapts said parser comprises to parse said text file as an XML file (para. 0036).

As per claim 21, Yach teaches wherein said interface comprises at least one screen (para. 0012, 0045) and said software further comprises object classes corresponding to actions to be taken by said device in response to interaction with said at least one screen (para. 0007, 0038),

As per claim 22, Yach teaches wherein said memory further stores said software component separate from said virtual machine software (Fig. 3, file storage).

As per claim 23, Yach teaches wherein said software component separate from said virtual machine software comprises at least one object class (para. 0047, 0036).

As per claim 24, Yach teaches wherein said software component separate from said virtual machine software comprises an interface recognized by said virtual machine software (Fig. 2).

As per claim 25, Yach teaches wherein said software component separate from said virtual machine software interacts with hardware at said mobile device (Fig. 1).

As per claim 26, Yach teaches wherein said software component separate from said virtual machine software receives parameters contained in said text file from said virtual machine software (para. 0038).

As per claim 27, Yach teaches wherein said software component separate from said virtual machine software returns data to said virtual machine software (para. 0047).

As per claim 28, Yach teaches wherein said software component separate from said virtual machine software returns data to said virtual machine software in XML format (para. 0007-0008).

As per claim 29, it is rejected by the same rationale as stated in claim 1 arguments. Furthermore, Yach teaches computer readable medium storing software to be executed at a mobile device (para. 0046).

### ***Conclusion***

The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M. LE whose telephone number is (571) 272-4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
DEBBIE LE  
PRIMARY EXAMINER  
12/13/07